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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,744	11/28/2000	John Thaddeus Pienkos		8432

7590 10/18/2006  
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EXAMINER

ZURITA, JAMES H

ART UNIT PAPER NUMBER

3625

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/724,744	<b>Applicant(s)</b> PIENKOS, JOHN THADDEUS	
	<b>Examiner</b> James H. Zurita	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 35,36,38,39,41 and 44-86 is/are pending in the application.
- 4a) Of the above claim(s) 44-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35,36,38,39,41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Prosecution History*

On 28 November 2000, applicant filed the instant application, claiming priority to provisional application 60/190770, filed on 20 March 2000.

On 30 September 2003, the Office issued an Election/Restriction Requirement.

On 31 October 2003, applicant cancelled claims 18-20 and added claims 21-23.

On 8 March 2004, the Examiner issued a non-final rejection of claims 1-17 and 21-23 as unpatentable over ***Business Wire*** (04/22/99), Swiss RE Develops Patent Validity Insurance for Patent and License Exchange, 2 pages, in view of an article by Margaret ***Quan***, Intellectual Property Exchange Takes Off, published on 10 March 2000 in EE Times, 1 page.

On 7 October 2004 (date on Return Receipt Post Card) applicant replied to the office action of 8 March 2004. The reply was entered on 13 September 2004.

On 21 September 2004, the application erroneously became abandoned for failure to respond to the Office Action. On 22 October 2004, the Office withdrew the holding of Abandonment.

On 3 January 2005, the Office issued a final rejection of claims 1-17, 21-23 as unpatentable over Business Wire and Quan.

On 6 May 2005, applicant requested continued examination. Applicant cancelled pending claims 1-17 and 21-23. Applicant added claims 24-43.

On 1 August 2005, the Examiner issued a non-final rejection.

On 6 January 2006, applicant filed a response.

On 46 April 2006, the Examiner issued a final rejection of pending claims.

On 26 May 2006, applicant requested continued examination.

On 16 July 2006, applicant submitted a preliminary amendment.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submissions filed on 26 May, 16 July and 17 July 2006 have been entered.

#### ***Response to Amendment***

On 17 July 2006, Applicant cancelled claims 24-34, 37, 40 and 42-43. Applicant added claims 44-58.

Claims 35-36, 38-39, 41 and 44-58 are pending. Claims 44-58 are withdrawn by original presentation.

Claims 35-36, 38-39 and 41 will be examined.

#### ***Election/Restriction***

Newly submitted claims 44-57 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

**Invention II**, including claims 35-41, currently being examined, directed to a method of facilitating a transfer of a first interest in a patent asset between first and second parties, classified in class 705, subclass 37.

**Invention III**, including claims 44-55, directed to an internet-based method of executing a transaction involving a transfer of an interest in an intellectual property asset between a first party and a second party, classified in class 705, subclass 37.

**Invention IV**, including claims 56-58, directed to an internet-based method of executing a transaction involving a transfer of an interest in an intellectual property asset to a first party from a second party, classified in class 705, subclass 37.

**Inventions II and III** are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. See MPEP § 806.05(d).

In the instant case, invention III has separate utility such as

- (b) performing processing in order to evaluate whether the intellectual property asset is at least one of desirable to the first party and available for transfer by the first party, wherein the processing is performed at least partly by way of the computer system of the first party and in response to the receiving of the first information, and wherein the processing involves other than merely a selection of a price corresponding to the intellectual property asset;
- (c) receiving at the computer system, from the second party via the internet second information regarding an extent of the interest in the intellectual property asset that is at least one of available for transfer from the second party to the first party and desired by the second party,
- (d) providing a proposed agreement regarding the transfer of the interest in the intellectual property asset between the first party and the second party, wherein the proposed agreement is generated at least in part based upon the second information

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and the search for one is not required for the other, restriction for examination purposes as indicated is proper.

**Inventions II and IV** are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. See MPEP § 806.05(d).

In the instant case, invention IV has separate utility such as

- (b) performing a valuation analysis to ascertain a value of the intellectual property asset, wherein the valuation analysis is performed at least partly in response to the receiving of the first information;
- (c) receiving at the computer system, from the second party via the internet, second information regarding an extent of the interest in the intellectual property asset that is available for transfer from the second party to the first party;

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and the search for one is not required for the other, restriction for examination purposes as indicated is proper.

**Inventions III and IV** are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. See MPEP § 806.05(d).

In the instant case, invention III has separate utility such as

- (b) performing processing in order to evaluate whether the intellectual property asset is at least one of desirable to the first party and available for transfer by the first party, wherein the processing is performed at least partly by way of the computer system of the first party and in response to the receiving of the first information, and wherein the processing involves other than merely a selection of a price corresponding to the intellectual property asset;

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and the search for one is not required for the other, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 44-57 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

### ***Response to Arguments***

Applicant's arguments with respect to claims 35-36, 38-39 and 41 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

Claims 35 and 39 refer to first interest and second interest and would appear to refer to a property right, title or legal share in something. Claim 35 also appears to use the term interest as holding or arousing interest in something.

The claims need to be revised to incorporate the idea of arousing interest in the patent asset, as in the specifications.

The terms will be interpreted as referring to property right, title or legal share in something.

Claim 38 refers to an ownership/possessory status of the patent asset. The forward slash renders the claim indefinite, since it is not possible to determine the scope of the claim as requiring both items or only one of the items separated by the forward slash. For purposes of this examination, examiner will give the term its broadest reasonable interpretation and consider that the particular condition is satisfied if one of the limitations is met.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 35-36, 38-39 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Kossovsky et al, PG-PUB 2002/0004775A1, published 10 January 2002, filed 20 April 2001, as application 09/839845, which is a continuation in part of application 09580005, filed May 26, 2000, which is a continuation of 09371614, filed 10 August 1999, which claims priority from 60124847, filed 17 March 1999.

**As per claim 35**, Kossovsky discloses facilitating a transfer of a first interest in a patent asset between first and second parties, the method comprising:

- receiving, at a computer system of the first party off of an internet-type communications link, first information concerning the patent asset (see, for example, at least Fig. 3 and related text);



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the first information includes at least one of a number identifying the patent asset, a filing date, an issue date, expiration information, a title, an inventor name, ownership information, descriptive information concerning a technical subject matter of the patent asset, product information regarding a product that is within a scope of the patent asset, and market information regarding a market to which the patent asset pertains (see, for example, at least Fig. 5A-5C for various types of information.

- receiving second information regarding an extent of the first interest in the patent asset (see, for example, references to searching the database, as in step 320, Fig. 3; Fig. 7A, 7B for different fields that show an interest in the patent asset.
- providing a proposed agreement regarding the transfer of the first interest in the patent asset between the first party and the second party, wherein the proposed agreement is provided by the first party (see, for example, at least references to transacting IP license and assignment agreement, as in paragraph 0009)
- transferring the first interest in the patent asset from one of the first party and the second party to the other of the first party and the second party by concluding one of the proposed agreement (see, for example, references to transferring property rights of intellectual property, as in paragraph 0007) and a modified version of the proposed agreement between the first party and the second party (see, for example, references to negotiated parameters, as in paragraph 0155).

***As per claim 36***, Kossovsky discloses that the proposed agreement is provided onto the Internet and wherein the patent asset includes at least one of a patent and a pending patent application.

***As per claim 38***, Kossovsky discloses performing processing to evaluate at least one of a financial value of the patent asset, a technological scope of the patent asset, a product coverage of the patent asset, a market for products covered by the patent asset, an ownership/possessory status of the patent asset, a validity status of the patent asset, and whether there have been one or more past inquiries concerning the patent asset. See, for example, at least paragraph 0054, concerning valuation; see market segment and valuation, as in paragraph 0045.

***As per claim 39***, Kossovsky discloses that the first interest is transferred from the first party to the second party (see, for example, references to transferring property rights of intellectual property, as in paragraph 0007) and further comprising:

transferring at least one of the first interest and a second interest in the patent asset from a third party to the first party by concluding a second agreement between the first party and the third party, wherein the second interest at least one of encompasses and is identical to the first interest (see, for example, at least references to intermediary qualified licensing agents, as in paragraphs 0060, 0119).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US 20020002524 A1, published 20020103 and US 20020002523 A1, published 20020103, WO 01/93154 A2, published 12 December 2001.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**James Zurita**  
**Primary Examiner**  
**Art Unit 3625**  
14 October 2006

*James Zurita*  
*Primary Examiner*